

Finally, the Examiner rejected Claims 1-6 and 8-24 under the doctrine of obviousness-type double patenting as being unpatentable over Claims 1-22 of U.S. Patent number 6,685,374 B1 issued to Cetera (the “‘374 Patent”), the Applicant of the instant invention.

## **II. Applicant’s Response**

Applicant submits herewith a Request for Continued Examination. Applicant has amended Claims 1 and 14 to provide for patentably distinct coverage from the ‘374 patent and believes that the instant amendments overcome the prior art rejections, as will be discussed in further detail below.

Applicant believes that a brief summary of the invention may be helpful to the Examiner. The subject of the present invention relates to a hand-held implement containing a clip assembly that is designed to accommodate large material between the body and the rigid member without deformation or breaking. Advantageously, it is the substantially wide angular displacement of the clip assembly that provides the clip with the ability to clip onto substantially large material. The body flanges are displaced radially outward from the outermost surface of the body to accomplish the increased angular displacement. As understood by Applicant, the prior art references do not disclose such features for wide angular displacement for the clip assembly and do not teach or provide any suggestion that the structural elements disclosed in each respective reference are capable of such wide angular displacement.

While Applicant recognizes the Examiner’s argument that the functional limitation of being able to clip a “large volume of, or thick, material” is not related to the structural elements of the claim, Applicant believes the instant amendments effectively provide structural limitations which avoid the prior art references since the maximum angular displacement is limited to 35

degrees.

**A. Applicant's Claims, As Amended, Are Patentably Distinct From the Claims Issued in the '374 Patent.**

Applicant respectfully disagrees with the Examiner's double-patenting rejection because Applicant believes the claims in the instant application are patentably distinct from those in the parent application, the '374 patent. As will be discussed in further detail below, amended independent Claims 1 and 14 provide for a broader limitation that claims a guide pin that is not tapered and does not have a slit along the longitudinal axis.

The Examiner stated that Applicant is not entitled to contend for broader coverage since "applicant fails to contend for the broader coverage in the parent application." Final Office Action, p.5. Applicant respectfully disagrees with the Examiner and directs the Examiner's attention to the '374 patent for support. Specifically, Applicant stated in the '374 patent that "In alternate embodiments, the guide pin could be a solid, substantially cylindrical metallic object adapted to be permanently housed between the body flanges 6, 7 (see FIG. 3) and clip flanges 15, 16 (see FIG. 4)." '374 Patent, col.3, lns. 3-7. Thus, as clearly provided in the parent application, it is not necessary for the guide pin to be tapered or to formed with a longitudinal slit. Moreover, the '374 patent does not claim a solid guide pin in combination with the radially displaced body flanges and the rigid member having a maximum angular displacement of approximately 35 degrees relative to the body.

**B. The Krause and Kehr References Do Not Suggest That the Clip is Capable of Having a Wide Angular Displacement.**

It is well settled that to modify references, there must be some suggestion to do so, even for simple changes or combinations. See In re Chu, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir.

1995) (“Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down”). In re Gordon, 733 F.3d 900, 902, 221 USPQ 1125, 1227 (Fed. Cir. 1984) (“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”). Thus, to modify a prior art reference to render a patent obvious requires that “the prior art suggested the desirability of the modification.” In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

As understood by Applicant, neither the Krause nor Kehr references disclose, teach, or suggest that the body flanges could be displaced radially outward from the outermost surface of the body, and that the respective clip assemblies have a wide angular displacement of 35 degrees. Applicant respectfully submits that these features are unique to the present invention and that the Examiner has failed to cite any desirability in the Krause or Kehr references for such features. This is especially so since it appears that the Krause ball clip in FIG. 1 and 5 will only have a single point of contact that is substantially weaker than the clip in the present invention.

### III. **Conclusion:**

To the extent that Applicant has amended independent Claims 1 and 14, Applicant respectfully submits that such amendments overcome the rejections based upon the Krause and Kehr references. Specifically, as understood by Applicant, neither the Krause nor Kehr references disclose, suggest, or teach an implement having structural elements capable which provide for such wide angular displacement as described herein.

In the respect that Applicant believes independent Claims 1 and 14 are amended and overcome the rejections, dependent claims 2-6, 8-10, 12-13, 15-21, and 23-24 are also believed to

be patentable.

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance and requests that such action be taken by the Examiner.

Respectfully submitted,

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